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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,809	10/30/2001	Robert E. Simonson	N908	2099
21125	7590	10/26/2004	EXAMINER	
NUTTER MCCLENNEN & FISH LLP WORLD TRADE CENTER WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			HO, UYEN T	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 10/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/021,809	SIMONSON, ROBERT E.	
	<b>Examiner</b>	<b>Art Unit</b>	
	(Jackie) Tan-Uyen T. Ho	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 July 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-10 and 15-29 is/are pending in the application.
- 4a) Of the above claim(s) 1,2 and 26-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-10 and 17-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/04; 9/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION.**

1. The information disclosure statement (IDS) submitted on 8/27/04 and 9/1/04 are acknowledged and considered.

***Election/Restrictions***

2. Applicant's election of Group II (claims 4-10, 17-25 generic to all species) in the reply filed on 7/29/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

***Claim Objections***

3. Claim 20 is objected to because of the following informalities: line 4, "is funnel" should be "is tunnel funnel". Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 4-14 and 21-25, are rejected under 35 U.S.C. 102(b) as being anticipated by Ogawa et al. (5,976,146).

Ogawa et al. disclose a dilator retractor/cannula (201, 205, 206, 405, 504) as claimed. Wherein the retractor/cannula includes a main elongated body, a distal end portion being contoured to match the bone structure of a patient, the retractor being a wide channel (col. 35, line 30 to col. 64, line 64).

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Wherein said contour is defined by a slope or by a tunnel (see figures 73, 88-89A, 98A-C, 100A, 101A, 102A, 106, 115, 129A).

In regard to claim 21-25, the cannula (201, 504) has a proximal end and a distal end, a lumen defining a working channel, the distal end being shaped to define a lateral passageway oriented at angle to the working channel, the passageway is oriented generally perpendicular to the working channel and sized to pass an spinal rod (401, 402) there through. The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the Ogawa et al. 's device which is capable of being used as claimed if one desires to do so.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogawa et al. '146. Ogawa et al. disclose dilator retractors/tubes/cannulas having slope or tunnel distal end and having tunnel funnel shaped (12, fig. 63A and 405, fig. 100A and 504, figs. 121, 132). Although, Ogawa et al. does not disclose a series of dilator retractors/tube/cannulas with a different length. It is well known in the art to make series of surgical tools in different sizes in order to provide a best fit for a patient during

a surgical procedure such that to certain tools having size would allow to fit in a small patient and certain tools having size would allow the surgeon to perform procedure on a bigger patient. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make a series of Ogawa et al.'s dilator retractors/cannulas in many different sizes in order to allow a surgeon to choose a best fit for a patient during a surgery procedure.

### ***Response to Arguments***

8. Applicant's arguments filed 3/22/04 have been fully considered but they are not persuasive. Applicant argues that the Ogawa et al. reference does not disclose cannulas that are wide channeled. Examiner disagrees. The instant specification defines "the dilator retractor 30 affords a wide channel for the surgeon to pass his instruments there through allowing the surgeon to perform the surgical procedure...." Ogawa et al. disclose dilator retractor/tubes/cannulas (201, 205, 206, 405, 504) having a wide channel for the surgeon to pass dilator and other instrument there through. The dilator retractor/tubes/cannulas (201, 205, 206, 405, 504) have sufficient opening with lighting for better viewing of the target area of the patient (see col. 1, line 66 to col. 2, line 4). The limitations of the claims do not exclude a cannula/dilator retractors that are used in combination with an endoscope. The functional limitations of the claims are deemed not to impose any structural limitations on the claims distinguishable over the Ogawa et al.'s device which is capable of being used as claimed if one desires to do so.

Applicant argues that Ogawa et al. fails to disclose cannulas that are in elliptical or ovoid in shape. Examiner disagrees. Ogawa et al. disclose cannulas (405, fig.

101A-B and 102A-B) in elliptical or ovoid shape. The claims do not exclude a cannula having a sheath of a soft material is intended to be inserted over the largest of the dilator having elliptical shape which may or may not retain the elliptical contour after it is installed in the body of the patient.

Applicant argues that the Examiner misses the point, the size isn't to provide the best fit for the patient but to provide the best instrument for the surgeon. The motivation for combining the references does not have to be the same motivation of the applicant for making the instant invention (see MPEP 2144).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is (703) 306-3421. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN or NGUYEN can be reached on 703-308-2154. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
(Jackie) Tan-Uyen T. Ho  
Patent Examiner  
Art Unit 3731

October 20, 2004

  
ANHTUAN T. NGUYEN  
PRIMARY EXAMINER

10/25/04